

### **REMARKS**

The Office Action dated April 6, 2011 and the Advisory Action dated July 25, 2011 have been received and reviewed. This response, filed along with a Request for Continued Examination (RCE) and a Petition for a Two-Month Extension of Time, is directed to that action.

A Declaration under 37 C.F.R. §1.132 from Inventor Karen Golz-Berner has been submitted herewith.

The applicants respectfully request reconsideration in view of the foregoing Declaration and the following remarks.

#### **Claim Rejections- 35 U.S.C. §103**

In the Advisory Action, the Examiner maintained the rejection of claims 17, 20, 23, 24, 26, 30, and 31 under 35 U.S.C. §103(a) as obvious over Stora (US 6,403,109) in view of Zastrow et al. (US 5,961,988); claims 18 as obvious over Stora in view of Zastrow and further in view of Gross et al. (US 5,637,318); claims 21 and 22 as obvious over Stora in view of Zastrow and further in view of Gross et al. (US 5,643,601); and claim 19 as obvious over Stora in view of Zastrow and Gross, and further in view of Pelle (US 5,811,083) and Nakanishi (US 6,576,623). The applicants respectfully traverse these rejections.

The applicant's again submit that the Examiner's calculations for the concentrations of the components of Stora's perfume emulsion composition are erroneous. Despite pointing out the calculation errors in the applicant's previous response, the Examiner stated that the "position has been fully considered but is not persuasive, particularly since the Applicant has not shown

how would have calculated Applicant's 'normalized' results". (See Advisory Action, page 2, lines 10-11). Any skilled artisan knows that when a solution is diluted, as proposed by the Examiner, the amount of solutes in solution remain constant. In order to account for increased solvent, the values for the solutes and solvent must be normalized to 100. This is a very basic calculation taught in nearly every introductory chemistry course, and involves first multiplying the original concentration of solvent (water) by five, dividing the original concentration of solutes by five, adding the total new concentrations to obtain a volume percentage of greater than 100, dividing 100 by the new volume percentage to obtain a value, and finally multiplying the value by each of the new concentrations.

In the present case, the calculation is conducted as follows. Stora's formulation (Example 1) is comprised of the following:

Perfuming base	10.05%
Silicone DC 345	24.93%
Perfluorodecaline	2.23%
Water	21.35%
1,2-Butanediol	36.43%
Surfactants	5.000%
<hr/>	
Total:	100%

A five-fold dilution with water yields the following result:

Perfuming base	10.05 / 5	=	2.01%
Silicone DC 345	24.93/ 5	=	4.99%
Perfluorodecaline	2.23/ 5	=	0.446%
Water	21.35* 5	=	106.75%
1,2-Butanediol	36.43/ 5	=	7.29%
Surfactants	5.000/5	=	1.00%
<hr/>			
Total:	122.486%		

In order to normalize the composition to 100%, which the Examiner failed to calculate, 100 is divided by 122.486 to obtain a value of 0.8164, which is then multiplied by each of the solute and solvent concentrations to obtain the following composition:

Perfuming base	2.01% x 0.8164= 1.64%
Silicone DC 345	4.99% x 0.8164= 4.07%
Perfluorodecaline	0.446% x 0.8164= 0.36%
Water	106.75% x 0.8164= 87.15%
1,2-Butanediol	7.29% x 0.8164= 5.95%
Surfactants	1.00% x 0.8164= 0.8164%
<hr/>	
Total:	100%

The Examiner suggested that whether the Examiner's calculation or the applicant's calculation was correct is irrelevant to the issue of obviousness because in either case, "the values still theoretically fall within the claimed composition". (Advisory Action, page 2, lines 13-14). The applicants respectfully, but strongly, take exception to this statement, for when a hypothetical dilution is proposed, as here, the resulting diluted composition must be compared not just to the claimed composition but also to the original prior art composition that was diluted. For if a proposed dilution renders the original prior art composition unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Moreover, if the proposed dilution would change the principle operation of the original prior art composition being diluted, then the teachings of the references are not sufficient to render the claims *prima facie* obviousness. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Accordingly, the Examiner's proposed dilution would render Stora unsuitable for its

intended use because the addition of water through an aqueous dilution would substantially change the formulation's refractive index. Indeed, Stora clearly and unequivocally stresses the importance of the refractive index of the emulsion, and the difference between the aqueous phase refractive index and the oil phase refractive index. In particular, the formulation has a refractive index of between 1.40 and 1.44, and a difference between oily phase and aqueous phase of 0.003 or less. (col. 2, lines 57-65; col. 4, lines 60-62) Since the refractive index of water is 1.33, a five-fold increase in water would substantially lower the formulation's refractive index, and would further increase the difference between the refractive index of the two phases.

Inventor Karen Golz-Berner conducted a comparative test, wherein a composition according to Stora's Example 1 was diluted with water by a factor of five. The results of this experiment show that the undiluted Example (Emulsion A) showed a difference in refractive index of the oily and aqueous phases of 0.0016, and was transparent. The diluted Example (Emulsion B), showed a difference in refractive index of 0.00417, and was not transparent. Accordingly, Stora would therefore be rendered unsuitable for its intended use as a *transparent* perfume composition.

The disclosures of Zastrow, Gross, Pelle and Nakanishi fail to remedy any of the deficiencies discussed hereinabove.

Based on the foregoing remarks, the applicants submit that a *prima facie* case of obviousness cannot be established, and respectfully request that the Examiner withdraw these rejections.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires any further extension of time, Applicants respectfully requests that this be considered a petition therefore. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By /Mark D. Marin/  
Mark D. Marin - Reg. No. 50,842  
875 Third Avenue, 8th Floor  
New York, New York 10022  
Tel. 212-808-0700